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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,639	03/25/2004	Joseph M. Ferencz	1927A1	7496

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PPG INDUSTRIES, INC.  
Intellectual Property Department  
One PPG Place  
Pittsburgh, PA 15272

EXAMINER
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COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/809,639

Applicant(s)

FERENCZ ET AL.

Examiner

Charles E. Cooley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 and 5-12 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No: \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **FINAL OFFICE ACTION**

### ***Election/Restriction Requirement***

1. This application contains claims 7-12 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Drawings***

2. The replacement drawing sheet was received on 20 OCT 2006 and is approved.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**5. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. (US 5,667,299) in view of Johnson et al. (US 4,344,710).**

Mizoguchi et al. (US 5,667,299) discloses in Figures 1-8 a single (col. 9, lines 29-33) or twin-screw extruder (Fig. 8) comprising one or more rotating screws 5; a plurality of adjacent segments 3a-3d surrounding the rotating screw(s), each of the segments including a cooling system 7a-7d for cooling material in the segment, and a heating system 4a-4d for heating material in the segment, wherein the cooling system and the heating system of each of the segments can be selectively, independently operated (col. 3, lines 8-18 and col. 7, lines 15-18), one of the segments having an inlet 6 for receiving material into the extruder and one of the segments having an outlet (a die - col. 1, lines 41-44) for discharging material from the extruder; wherein each cooling system includes a cooling fluid inlet and outlet in each segment as seen in Figure 1. Mizoguchi et al. thus discloses all of the recited subject matter with the exception of the recited additive injector. The patent to Johnson et al. (US 4,344,710) discloses an extruder 30 comprising one or more rotating screws; heating systems 34 surrounding the rotating screw(s) for heating material in the segment; an additive injector 24 for injecting additives into a section of the extruder at an injection position between the inlet 30 and the outlet 38; wherein the injector includes a pressure vessel 100, and a flow regulator 118 between the pressure vessel and the injection position; a source of

pressurization coupled to the pressure vessel for pressurizing the pressure vessel (col. 2, lines 3-5); and a pressure regulator 110 capable of controlling the pressure to any desired value in the injection line 106. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the heated/cooled extruder of Mizoguchi et al. with an additive injector as taught by Johnson et al. '710 for the purposes of enabling the injecting of a plurality of diverse fluids from a source to an injection zone of the extruder and to control the amount of fluid injected (col. 1, line 62 - col. 2, line 2).

**6. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. (US 5,667,299) in view of Chang et al. (US 5,318,431).**

Mizoguchi et al. (US 5,667,299) discloses in Figures 1-8 a single (col. 9, lines 29-33) or twin-screw extruder (Fig. 8) comprising one or more rotating screws 5; a plurality of adjacent segments 3a-3d surrounding the rotating screw(s), each of the segments including a cooling system 7a-7d for cooling material in the segment, and a heating system 4a-4d for heating material in the segment, wherein the cooling system and the heating system of each of the segments can be selectively, independently operated (col. 3, lines 8-18 and col. 7, lines 15-18), one of the segments having an inlet 6 for receiving material into the extruder and one of the segments having an outlet (a die - col. 1, lines 41-44) for discharging material from the extruder; wherein each cooling system includes a cooling fluid inlet and outlet in each segment as seen in Figure 1. Mizoguchi et al. thus discloses all of the recited subject matter with the exception of the

recited additive injector. The patent to Chang et al. (US 5,318,431) discloses an extruder 1 comprising one or more rotating screws; heating systems 17 surrounding the rotating screw(s) for heating material in the segment; one or more additive injectors 27 for injecting additives into a section of the extruder at an injection position between the inlet 13 and the outlet 19 (the injectors can be located at any desired position along the extruder as taught by col. 6, lines 16-32); wherein the injector includes a pressure vessel 53, and a flow regulator 43 between the pressure vessel and the injection position; a source of pressurization 56 and/or 63 coupled to the pressure vessel for pressurizing the pressure vessel; and a pressure regulator 47, 57 and/or 61 capable of controlling the pressure to any desired value. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the heated/cooled extruder of Mizoguchi et al. with an additive injector as taught by Chang et al. '431 for the purposes of enabling the injecting of a plurality of substances from a source to an injection zone of the extruder and to control the amount of fluid injected thereby altering the composition of the extruded product to a desired state and to control the melt temperature of the composition (col. 3, lines 23 - col. 4, line 22).

**7. Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi et al. (US 5,667,299) in view of Rizvi et al. (US 5,120,559).**

Mizoguchi et al. (US 5,667,299) discloses in Figures 1-8 a single (col. 9, lines 29-33) or twin-screw extruder (Fig. 8) comprising one or more rotating screws 5; a plurality of adjacent segments 3a-3d surrounding the rotating screw(s), each of the segments

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including a cooling system 7a-7d for cooling material in the segment, and a heating system 4a-4d for heating material in the segment, wherein the cooling system and the heating system of each of the segments can be selectively, independently operated (col. 3, lines 8-18 and col. 7, lines 15-18), one of the segments having an inlet 6 for receiving material into the extruder and one of the segments having an outlet (a die - col. 1, lines 41-44) for discharging material from the extruder; wherein each cooling system includes a cooling fluid inlet and outlet in each segment as seen in Figure 1.

Mizoguchi et al. thus discloses all of the recited subject matter with the exception of the recited additive injector. The patent to Rizvi et al. discloses an extruder 20 comprising one or more rotating screws 22; heating system 30 surrounding the rotating screw(s) for heating material in the segment; one or more additive injectors 32, 46 for injecting additives into a section of the extruder at an injection position between the inlet 18 and the outlet 90; wherein the injector includes a pressure vessel 51, and a flow regulator 68 between the pressure vessel and the injection position; an inherent source of pressurization coupled to the pressure vessel 51 for pressurizing the pressure vessel since the vessel is pressurized; a pressure regulator 70 capable of controlling the pressure to any desired value (col. 5, lines 32-39); and a pre-mix hopper 10, 14 and a mechanical feeder (the screw between 12 and 18) extending from an exit of the pre-mix hopper to the inlet 18 of the extruder 20. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the heated/cooled extruder of Mizoguchi et al. with an additive injector and hopper with feeder as taught by Rizvi et al. for the purposes of enabling the injecting of a plurality of

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substances from a source to an injection zone of the extruder and to control the amount of fluid injected thereby altering the characteristics of the extruded product to a desired state (such as texture, appearance, flavor, viscosity, pH, color), and to premix multiple materials before entering the extruder via the hopper and feeder (col. 1, lines 6-10 and lines 43-47; col. 7-15 and lines 53-67; col. 4, lines 42-53; and col. 5, lines 31-39).

### ***Response to Amendment***

8. Applicant's arguments filed 20 OCT 2006 have been fully considered but they are not persuasive.

Applicant argues that the applied prior art is not concerned with preparation of powder coatings. However, the elected claims are strictly apparatus claims and with regard to the recitations of powder coatings that Applicant relies upon for patentability in the remarks, a recitation with respect to the material intended to be worked upon by a claimed apparatus (the powder coatings in this instance) does not impose any structural limitations upon the claimed apparatus, which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. See *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. App. 1987). Also see *In re Rishoi*, 197 F.2d 342, 344, 94 USPQ 71, 72 (CCPA 1952). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as

restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Accordingly, the recitation of what particular substances are being processed in the claimed apparatus is not germane to the patentability of the apparatus itself. Since all of the claimed structural elements are met by the prior art applied above under 35 U.S.C 103, the rejections are considered proper.

Regarding the pressure recited in the claims, the only structure recited in claim 1 is a low pressure vessel (whatever the metes and bounds of "low" are) and a pressure maintaining mechanism, structure that is clearly disclosed in the applied prior art. The vessels of the prior art are considered quite capable of operating at said low pressure and the pressure maintaining mechanisms are considered to be inherently or explicitly capable of maintaining the pressure at any desired pressure, including the range recited in claim 1. The examiner does not foresee allowance of the apparatus claims simply as a function of the recited pressure in view of the combined teachings of the prior art.

Applicant further states that the recited extruder is "a significant advance in the art" and "apparatus useful for the production of toner, thermoplastic foam, or dough is not necessarily readily adapted for use in the preparation of powder coatings".

Applicant's position on this point is considered to be speculative attorney's argument unsupported by objective technical evidence on the issue. Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Claim 1 recites "wherein the extruder is suitable for use in a method of making powder coatings at a pressure of less than about 100 PSI" and Applicant further argues the use of the extruder for powder coating production, however, such an intended use has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641.

In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Since all of the applied prior art is drawn to screw extruding devices, Applicant's assertion that the references constitute non-analogous art is not compelling.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri. The examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Charles E. Cooley", followed by a stylized flourish.

Charles E. Cooley  
Primary Examiner  
Art Unit 1723

8 November 2006